UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,488	05/08/2006	Yasuhiro Hidaka	3712174-00548	1355

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EXAMINER
RUST, ERIC A

ART UNIT	PAPER NUMBER
2625	

NOTIFICATION DATE	DELIVERY MODE
02/16/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>10 January 2011</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>37-48</u> is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>37-48</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All   b)☐ Some *   c)☐ None of:

　　　　1.☐ Certified copies of the priority documents have been received.

　　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date <u>01/10/2011</u>.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January

10, 2011 has been entered.

        In the Amendment filed on January 10, 2011 Applicants amended claims 37, 41,

and 45. Claims 37-48 are pending.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 37-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over

U.S. Patent Application No. 2001/0053247 A1 to Sowinski et al. (hereinafter, Sowinski)

in view of U.S. Patent No. 6,821,034 B2 to Ohmura and further in view of U.S. Patent

Application No. 2002/0145755 A1 to Yamazaki et al. (hereinafter, Yamazaki).

In regard to claims 37, 41, and 45, Sowinski discloses a print-ordering system comprising: a user terminal having a display device (**Sowinski, Fig. 5 for user terminal, Fig. 5, item 509 for display device**); a server having an image database (**Sowinski, Fig. 6, and [0127], image database is inherent since sample images are being used**); a print system; at least one processor (**Sowinski, Fig. 5, item 505 and/or 510**); at least one memory device (**Sowinski, Fig. 5, item 511**) storing a plurality of instructions which when executed by the at least one processor, cause the at least one processor to operate with the user terminal (**Sowinski, [0152]**), the server and the print system to:

(a) enable a user to select:

(i) a predetermined sample image stored in the image database (**Sowinski, [0127]**);

(b) in response to the predetermined sample image being selected:

(i)cause the server to generate a plurality of first image-processing-mode-selection images based on said predetermined sample image, each of said first image-processing-mode-selection images being subjected to different image processes (**Sowinski, Fig. 10, item 1004, and [0127]**);

(ii) cause the display device to display each of said generated first image processing-mode-selection images (**Sowinski, Fig. 10, item 104, and [0127]**);

(iii) enable the user to select one of the displayed first image-processing-mode- selection images (**Sowinski, Fig. 10, item 104, and [0127]**);

(iv) in response to one of the displayed image-processing-mode-selection images being selected, cause the server to store a first image processing mode based on said selected first image-processing-mode-selection image (**Sowinski, Fig. 10, item 104, and [0127]**); and

(v) cause the printer system to execute print processing based on the first image processing mode stored by said server (**Sowinski, Fig. 10, item 104, and [0127], and [0140], based on first, second, and third image processing mode, this, of course, includes first image processing mode**).

It does not appear that Sowinski discloses enabling a user to select an image stored in the user terminal; and in response to the image stored in the user terminal being selected:

(i) transmitting the image stored in the user terminal to the server;

(ii) causing the server to generate a plurality of second image-processing-mode-selection images based on said transmitted image, each of said second image-processing-mode-selection images being subjected to different image processes;

(iii) causing the display device to display each of said generated second image-processing-mode-selection images;

(iv) enabling the user to select one of the displayed second image-processing-mode-selection images;

(v) in response to one of the displayed second image-processing-mode-selection images being selected, cause the server to store a second image processing

mode based on said selection of the displayed second image- processing-mode-selection image; and

   (vi) causing the printer system to execute print processing based on the second image processing mode stored by said server, or that that the predetermined sample image is not owned by the user.

  The Examiner notes, however, that the only difference between claims 37, 41, and 45 and Sowinski is that claims 37, 41, and 45 allow a user to select his own image on the client device and then use that image for the processing that would be done on the sample image as disclosed in Sowinski and that that the predetermined sample image is not owned by the user.

  Taking this into consideration, Ohmura discloses that a user can transmit an image to a shop for processing through the internet (**Ohmura, col. 1, lines 20-25**).

  Sowinski and Ohmura are combinable because they both deal processing an image.

  Thus, it would have been obvious to one of ordinary skilled in the art at the time of the invention looking at the disclosures of both Sowinski and Ohmura to provide an improved function of allowing a user to transmit an image from his/her PC to a shop for processing through the internet.

  The modification to Sowinski could be accomplished by allowing a user to transmit an image from his/her PC to a shop for processing through the internet to the system of Sowinski according to the teaching of Ohmura to obtain the invention as specified in the claim.

Further a person of ordinary skill in the art would have recognized the compatibility of allowing a user to transmit an image from his/her PC to a shop for processing through the internet with the system of Sowinski.

The combination has a reasonable expectation of success in that the modifications can be made using conventional and well known engineering and programming techniques, and both Sowinski and Ohmura are not altered and continue to perform the same function separately, and the resultant combination produces the highly predictable result of allowing the a user to process an image.

One of ordinary skilled in the art would have been motivated to combine the teachings of Sowinski and Ohmura in order to increase the amount of images available to a user, and so that a user can work process his/her own image that may have just been produced. This would increase user satisfaction.

Moreover, one of ordinary skilled in the art at the time of the invention would have been motivated to combine the teachings of Sowinski and Ohmura so that a processing shop could accept images from everywhere (**Ohmura, col. 1, lines 36-38**). This would allow for increased revenue and owner satisfaction.

The combination of Sowinski and Ohmura would result in the limitations of claims 37, 41, and 45, less the limitation that that the predetermined sample image is not owned by the user.

Ohmura does not disclose that the predetermined sample image is not owned by the user.

Yamazaki, however, discloses using sample images not owned by a user for processing (**Yamazaki, [0024] and [0046]**).

It would have been obvious to one of ordinary skilled in the art at the time of the invention to combine the teachings of Yamazaki with the teachings of Sowinski and Ohmura for using sample images not owned by a user for processing in order to reduce the bandwidth that is used and thereby reduce the time the user has to wait to access the system (**Yamazaki, [0006]**). That is, if a user uses a sample image not owned by the user, the user does not have to upload images before, for example trying out the system. This increases user satisfaction.

Another motivation for the combination would be to increase the amount of images available to a user for processing. This increases user satisfaction.

In regard to claims 38, 42, and 46, which depend from claims 37, 41, and 45, respectively, the combination of Sowinski and Ohmura disclose wherein when execute by the at least one processor, the instructions cause the processor to operate with the user terminal and the server to, for at least one of the first image processing mode and the second image processing mode, transmit, to the User terminal, at least two image-processing-mode-selection images obtained by performing a multilevel-image processing (**Sowinski, Fig. 10, item 104, and [0127], and Ohmura, col. 1, lines 20-25**).

 In regard to claims 39, 43, and 47, which depend from claims 37, 41, and 45, respectively, the combination of Sowinski and Ohmura disclose wherein when execute by the at least one processor, the instructions cause the processor to operate with the user to terminal to:

 (a) enable the user to select a type of image processing mode (**Sowinski, Fig. 10, item 104, and [0127]**); and

 (b) determine the first or the second image processing mode based on said selected type (**Sowinski, Fig. 10, item 104, and [0127], and Ohmura, col. 1, lines 20-25**).

 In regard to claims 40, 44, and 48, which depend from claims 37, 41, and 45, respectively, Sowinski discloses the first image processing mode and the second image processing mode include outline emphasis, hue, color density, gradation or contrast (**Sowinski, [0126], lines 3-12, hue**).

Response to Arguments

4.   Applicants' arguments with respect to claims 37-48 have been carefully considered but are rendered moot in view of new grounds of rejection.

Conclusion

5.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC A. RUST whose telephone number is (571)-270-

3380. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00

p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Benny Tieu can be reached on (571)-272-7490. The fax phone number for

the organization where this application or proceeding is assigned is 571-270-4380.

Information regarding the status of an application may be obtained from the

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ERIC A. RUST/

Examiner, Art Unit 2625

02/08/2011

/Benny Q Tieu/

Supervisory Patent Examiner, Art Unit 2625